



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,336	12/05/2000	Laszlo Hars	US000343	8183

24737 7590 07/09/2004

PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

EXAMINER

FAULK, DEVONA E

ART UNIT PAPER NUMBER

2644

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

4

Office Action Summary

Application No.

09/730,336

Applicant(s)

HARS, LASZLO

Examiner

Devona E. Faulk

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 0200.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-13 and 17-20 is/are allowed.
- 6) ☒ Claim(s) 1-9, 14-16 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2. | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. **Claims 1-9 and 14-16** are provisionally rejected under the judicially created doctrine of double patenting over claims 1-6, 8-12 and 17-18 of copending Application No. 09/732,965.

This is a provisional double patenting rejection since the conflicting claims have not yet been patented. The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: claim 1-9 and 14-16 of application 09/730336 disclose a system for verifying a digital recording, and a program product stored on recordable media for verifying a digital recording. The system and program product have the same functionality and features as the system and program product disclosed in claims 1-6,8-12 and 17-18 of application 09/732,965. Claims 1-6,8-12 and 17-18 of Application No. 09/732,965 are broader than claims 1-9 and 14-16 of Application No. 09/730,336 and thus anything that infringed on the narrower claims 1-9 and 14-16 would infringe on the broader claims 1-6,8-12 and 17-18.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims **6,15,16 and 21** are rejected under 35 U.S.C. 102(e) as being anticipated by Davis et al. (U.S. Patent 6,611,607).

Regarding claims 6 and 14, Davis discloses a mechanism for reading watermarks from each of a plurality of sections on the digital recording and extracting a first and second part from each watermark (column 7, lines 5-10); a mechanism for calculating a first identifier as a function of the extracted first parts (column 7, lines 5-10); a mechanism for calculating a second identifier based on a subset of the second extracted parts (column 7, lines 8-10); and a mechanism for comparing the first identifier and the second identifier (column 7, lines 5-10). Davis teaches that the media signal may be audio frames in an audio sequence (column 2, lines 21-24).

All elements of **claim 15 and 16** are comprehended by claim 14. A hash value is a subset of integers.

Regarding claim 21, Davis teaches of watermarked digital recording having a plurality of tracks (column 3, lines 52-55; column 10, lines 29-35) and of a plurality of sections commingled

Art Unit: 2644

with the plurality of tracks, wherein each sections includes a random value and a value that is dependent on the random values for all the sections. (column 7, lines 2-13; column 7, lines 9-12)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 7 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al. (U.S. Patent 6,611,607) .

Claim 7 claims the system of claim 6 wherein the first part of each watermark is a random number. As stated above apropos of claim 6, Davis meets all elements of that claim. Therefore, Davis meets all elements of claim 7 with the exception of the claimed matter. Introducing some entropy like a random number as part of a watermark is well known in the art. Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to have the first part of each watermark be a random number for the benefit of minimizing the amount of perceptible data.

Claim 8 claims the system of claim 7 wherein the second part of each watermark is a hash of a complete set of random numbers from an original copy of the digital recording. . As stated above apropos of claim 6, Davis meets all elements of that claim. Therefore, Davis meets all elements of claim 8 with the exception of the claimed matter. Davis further teaches of the identifier calculated as a hash of the data (column 7, lines 2-12). Thus it would have been obvious to hash the data as claimed in order to be able authenticate the data.

Art Unit: 2644

7. **Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al. (U.S. Patent 6,611,607) in view of Yoshida et al. (6,674,874).

Claim 9 claims the system of claim 6 further comprising a mechanism for terminating further processing of the digital recording if the first and second identifier do not match. As stated above apropos of claim 6, Davis meets all elements of that claim. Therefore, Davis meets all elements of claim 9 with the exception of the claimed matter. Yoshida teaches a mechanism for terminating further processing of the digital recording if the first and second identifier do not match (column 14, lines 7-24). Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize Yoshida's method of terminating because it offers the advantage of ensuring that only original audio data can be outputted.

Claim Objections

8. **Claim 1** is objected to, but would be allowable if the double patent rejection is overcome.

Allowable Subject Matter

9. **Claims 10-13 and 17-20** are allowable.

10. The following is an examiner's statement of reasons for allowance.

Regarding **claim 10**, prior art, Davis et al. (U.S. Patent 6,611,607) discloses a mechanism for dividing the digital recording into a plurality of sections, a mechanism for calculating an identifier, and a watermarking mechanism for watermarking sections within a block of sections. Prior art, Chen et al. (U.S. Patent 6,671,387) teaches of a watermark generated by a random number generator. Prior art, Leighton (U.S. Patent 5,949,885) discloses a watermark that could be a random string generated by a hash. Prior art, Yoshida et al. (U.S. Patent 6,674,874),

Art Unit: 2644

discloses associating a block number with each block of data. However the prior art of combination thereof fails to disclose, "means for determining a watermark for each section within a block of sections, wherein each watermark includes the value assigned to the section and a portion of the identifier". As such, the prior art fails to disclose or make obvious the program product as claimed.

Claims 11-13 are allowable due to dependency on claim 10.

Regarding **claim 17**, prior art, Davis et al. (U.S. Patent 6,611,607) discloses a mechanism for dividing the digital recording into a plurality of sections, a mechanism for calculating an identifier, and a watermarking mechanism for watermarking sections within a block of sections. Prior art, Chen et al. (U.S. Patent 6,671,387) teaches of a watermark generated by a random number generator. Prior art, Leighton (U.S. Patent 5,949,885) discloses a watermark that could be a random string generated by a hash. Prior art, Yoshida et al. (U.S. Patent 6,674,874), discloses associating a block number with each block of data. However the prior art of combination thereof fails to disclose, "watermarking each section in each block with the random number for the section and one of the m partitions". As such, the prior art fails to disclose or make obvious the system for marking a digital recording as claimed.

Claims 18-20 are allowable due to dependency on claim 17.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Devona E. Faulk whose telephone number is 703-305-4359. The examiner can normally be reached on 8 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W. Isen can be reached on 703-305-4386. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DF



**FORESTER W. ISEN
SUPERVISORY PATENT EXAMINER**